

**REMARKS/ARGUMENTS****I. General**

Claims 1-17 and 19-20 are pending in the application and were rejected in the Office Action. The issues in the Office Action are as follows:

- Claims 1-4, 7-11, and 19-20 are rejected under 35 U.S.C. § 102(b) as being unpatented by *Sehr* (U.S. Patent No. 6,085,976).
- Claims 12-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sehr* (U.S. Patent No. 6,085,976) in view of *Lee* (U.S. Patent No. 5,702,166).
- Claims 5-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sehr* (U.S. Patent No. 6,085,976) in view of *Rhoads* (U.S. Patent No. 6,311,214).

In response, Applicants hereby traverse the outstanding rejections and request reconsideration and withdrawal in light of the amendments and remarks contained herein.

**II. Amendments**

Applicants have amended claims 1, 8, and 13 in the manner described further below.

Claim 1, as amended, recites in part:

“a printer communicatively coupled to said at least one processor unit to print the contact information to a tag and to print at least the encoded portion of said traveler information on a tag in said machine-readable format.”

No new matter has been added by the amendment of claim 1. The claim amendment is supported at least at page 4, lines 23-25 of the original application.

Claim 8, as amended, recites in part:

“wherein said traveler information further includes a travel itinerary for said traveler and wherein said travel itinerary is printed on said tag.”

No new matter has been added by the amendment of claim 8. The claim amendment is supported at least at page 10, lines 4-9 of the original application.

Claim 13 has been amended to incorporate claim 18, thus effectively re-writing claim

18 in independent form as claim 13. Claim 13, as amended, recites in part:

“user information to a tag in said machine-readable format, wherein said at least a portion of said user information encoded into said machine-readable format includes said contact information.”

No new matter has been added by the amendment of claim 13. Because its limitations are included in claim 13, claim 18 is deleted without prejudice.

### **III. Claim Rejections**

#### Rejections under 35 U.S.C. § 102

Claims 1-4, 7-11, and 19-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Sehr* (U.S. Patent No. 6,085,976). It is well settled that to anticipate a claim, the reference must teach every element of the claim. *See M.P.E.P. § 2131*. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he elements must be arranged as required by the claim.” *See M.P.E.P. § 2131* (citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990)). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the. . .claim.” *See M.P.E.P. § 2131* (citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989)). Applicants respectfully assert that the rejection does not satisfy these requirements.

Applicants respectfully submit that no one embodiment disclosed in *Sehr*, either expressly or inherently, discloses all of the limitations of claims 1-4, 7-11, and 19-20 as discussed below.

#### Claim 1 and its dependent claims

As amended herein, claim 1 recites a printer to “print the contact information to a tag and to print at least the encoded portion of said traveler information on a tag in said machine-readable format.” As shown on page 4, lines 15-21 of Applicants’ specification, contact information is included on a generated baggage tag. *Sehr* does not teach contact information printed on a tag in any format.

*Sehr* teaches a passenger card for the automated use of a traveler's permit and of other travel-related documents, purchase of goods and services, and the rendering of travel services. *Sehr* teaches storing a great deal of information, such as electronic representations of a passenger's drivers license or passport, to a database associated with its passenger card (Col. 32, lines 8-14). However, *Sehr* fails to teach printing that information on a tag. Thus, while contact information may be stored to a database associated with the passenger card, such contact information is not printed on a tag in *Sehr*. In column 34, lines 44-51, *Sehr* states that the tag has information that identifies the passenger as the owner of the luggage and the destination for the luggage, but this alone is not contact information. This is the same information that may be traditionally included on luggage tags and does not include information for contacting the passenger. The tag in *Sehr* is merely for identifying the passenger with his/her luggage at time of retrieval, and does not provide information on how to contact the traveler, e.g., in the event the luggage is mishandled. Therefore, Applicants respectfully assert that for the above reasons, claim 1 is patentable over the 35 U.S.C. § 102 rejection of record.

Claims 2-4 and 7-11 depend directly from independent claim 1, and thus inherit all limitations of claim 1. Each of the claims 2-4 and 7-11 recites features not taught by *Sehr*. As an example, claim 2 requires that contact information include temporary contact information. The Office Action claims that *Sehr* teaches a system, wherein the contact information includes temporary contact information; however, this is not taught in *Sehr*. While the database in *Sehr* may contain contact information for a passenger, the information remains in the database and is not printed on a tag, as recited by claim 1. Further, *Sehr* does not teach that temporary contact information, such as a hotel or residence of a relative or friend at which the traveler will be temporarily residing, will be printed on a tag. Further, amended claim 8 discloses that the travel itinerary is printed on a tag. *Sehr* does not disclose printing a travel itinerary on a tag. Thus, Applicants respectfully assert that for the above reasons, claims 2-4 and 7-11 are patentable over the 35 U.S.C. § 102 rejection of record.

Claim 19 and its dependent claim

Claim 19 requires "outputting at least the encoded contact information to a tag in said machine-readable format." *Sehr* fails to teach or suggest that contact information is encoded

and outputted to a tag. Again, *Sehr* teaches a tag that has information to identify the passenger as the owner of the luggage and the destination for the luggage (see Col. 34, lines 44-51), but this alone is not contact information. The Examiner cites Applicants to a portion of *Sehr* (Col. 10, lines 1-21) that identifies that a label with data relating to the ticket and transportation carrier can be printed out, but this label does not include contact information.

Further, *Sehr* fails to teach that contact information is printed on a tag in machine-readable format. As previously discussed, *Sehr* teaches storing information to a database, but it does not teach printing that information on a tag. Although information may be printed on a tag, *Sehr* does not teach printing contact information on a tag in machine-readable format. Therefore, Applicants respectfully assert that in view of the above, claim 19 is patentable over the 35 U.S.C. § 102 rejection of record.

Claim 20 depends directly from independent claim 19, and therefore, inherits all limitations of claim 19. Thus, Applicants respectfully assert that for the above reason, claim 20 is patentable over the 35 U.S.C. § 102 rejection of record.

Rejections under 35 U.S.C. § 103(a)

Claims 12-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sehr* (U.S. Patent No. 6,085,976) in view of *Lee* (U.S. Patent No. 5,702,166). Applicants have deleted claim 18 without prejudice. Applicants respectfully traverse the rejections of claims 12-17 in view of the comments below.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Without conceding the first and second criteria, Applicants assert that the rejection does not satisfy the third criterion.

The Office Action admits that *Sehr* does not teach a kiosk. The Office Action attempts to cure this deficiency by introducing *Lee*, which the Office Action alleges to teach

having such a kiosk. However, this combination, as presented, does not teach or suggest all features recited in claims 12-17, as discussed below.

Claims 13-17

Amended claim 13 recites in part, “means for outputting at least the encoded portion of said user information to a tag in said machine-readable format, wherein said at least a portion of said user information encoded into said machine-readable format includes said contact information.” The combination of *Sehr* and *Lee* fails to teach or suggest at least the above limitations of independent claim 13.

Claim 13 recites that the user information is “useful for reconciliation of a user item with said user, said user information including contact information for said user.” Thus, independent claim 13 recites that the user information includes contact information, and this contact information is outputted to a tag in a machine-readable format. As previously discussed, *Sehr* fails to teach or suggest outputting contact information to a tag in machine-readable format. Although the user’s name and destination are printed on the tag in *Sehr*, this alone is not contact information for the user.

Further, *Lee* fails to teach or suggest outputting any information to a tag in machine-readable format. The information kiosk of *Lee* serves to provide information to users, but the Office Action has not shown that this kiosk outputs encoded user information to a tag in machine-readable format. The Office Action states that combining *Lee* and *Sehr* would provide self-services for many types of proceedings such as travel, hotel, shopping, sport and leisure activities, but this does not overcome the lack of suggestion for outputting user information to a tag in machine-readable format.

In view of the above, the combination of *Sehr* and *Lee* fails to teach or suggest all of the limitations of claim 13. Thus, Applicants submit that claim 13 is not obvious under 35 U.S.C. § 103(a) over *Sehr* in view of *Lee*, and therefore, Applicants respectfully request withdrawal of this rejection. Further, claims 14-17 depend directly from independent claim 13 and therefore inherit all limitations of independent claim 13. Each of claims 14-17 sets forth features and limitations not recited by *Sehr* and *Lee*. Thus, Applicants respectfully assert that for the above reason claims 13-17 are patentable over the § 103 rejection of record.

Claim 12

With respect to claim 12, claim 12 depends directly from independent claim 1, and thus inherits all limitations of claim 1. Claim 12 recites features not taught or suggested by the combination of *Sehr* and *Lee*. As previously discussed, *Sehr* fails to teach or suggest a printer to “print the contact information to a tag and to print at least the encoded portion of said traveler information on said tag in machine-readable format” from claim 1, and combining *Sehr* with *Lee* fails to provide all the elements recited in claim 1. Thus, Applicants respectfully assert that for the above reason, claim 12 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 5-6

Claims 5-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sehr* (U.S. Patent No. 6,085,976) in view of *Rhoads* (U.S. Patent No. 6,311,214). Again, *Sehr* fails to teach or suggest a printer to print contact information on a tag as recited in claim 1, and combining *Sehr* with *Rhoads* fails to provide all the elements required. Claims 5-6 depend directly from independent claim 1, and thus inherit all limitations of claim 1. Each of the claims 5-6 requires features not taught or suggested by the combination of *Sehr* and *Rhoads*. As an example, the Office Action admits that *Sehr* fails to disclose contact information, which includes a group consisting of a mobile or cellular telephone number and a pager number. The Office Action attempts to cure this deficiency by introducing *Rhoads*, which the Office Action alleges to teach having such element. While the teaching of *Rhoads* mentions a cellular phone, it fails to teach that this contact information is printed on a tag. Combining *Sehr* with *Rhoads* fails to provide the recited elements of claims 5-6, and thus, Applicants respectfully assert that for the above reason, claims 5-6 are patentable over the 35 U.S.C. § 103 rejection of record.

Conclusion

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned “Version with markings to show changes made.”

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 1006795-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail Airbill No. EL 372554121US in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Date of Deposit: April 29, 2003

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Respectfully submitted,

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**Version With Markings to Show Changes Made**

1. (Amended) A system comprising:
  - at least one processor unit;
  - at least one user input device communicatively coupled to said at least one processor unit;
  - a display device communicatively coupled to said at least one processor unit;
  - software code executable by said at least one processor unit to receive as input traveler information that includes contact information for a traveler and further executable to encode at least a portion of said traveler information into a machine-readable format; and
  - a printer communicatively coupled to said at least one processor unit to print the contact information to a tag and to print at least the encoded portion of said traveler information on [a] said tag in said machine-readable format.
8. (Amended) The system of claim 1 wherein said traveler information further includes a travel itinerary for said traveler and wherein said travel itinerary is printed on said tag.
13. (Amended) A kiosk comprising:
  - means for processing computer-executable instructions;
  - means for receiving user input, the input receiving means communicatively coupled to the processing means;
  - means for displaying output to a user, the display means communicatively coupled to the processing means;
  - software code that is executable by the processing means for receiving as input user information useful for reconciliation of a user item with said user, said user information including contact information for said user; and
  - software code that is executable by the processing means for encoding at least a portion of said user information into a machine-readable format; and
  - means for outputting at least the encoded portion of said user information to a tag in said machine-readable format, wherein said at least a portion of said user information encoded into said machine-readable format includes said contact information.

Claim 18 is deleted without prejudice.